

File No. 20107/1200838-US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Earl ROTMAN et al.

Confirmation No. 3328

Serial No.: 10/709,329

Group Art Unit: 3628

Filed: April 28, 2004

Examiner: Nga B. Nguyen

For: **SYSTEM AND METHOD FOR CREATING TRADEABLE FINANCIAL UNITS**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of a Notice of Appeal, and in accordance with the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-appeal brief review of the rejection mailed May 26, 2005 in the above-identified application. No amendments are being filed with this request.

Claims 1-74 are pending in the application, with claims 1-31 having been twice rejected. An appeal is proper in accordance with 37 C.F.R. § 41.31(a), which provides that “[e]very applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board”

different state or thing because the claimed structure has a separate identity from the underlying equity and debt. Accordingly, the claimed article is a useful, concrete, and tangible item and, therefore, consequently meets the requirements of 35 U.S.C. § 101.

Further, with respect to additional claims 32-49, 61-62 and 73-74 these claims should be considered separate from the other article claims. These claims were added by the December 3rd Response and recite additional structural features, interrelationships, or practical applications having a useful concrete, and tangible result. The Examiner has erred in ignoring the pertinence of these additional features by stretching the prior rejection under § 101 to these claims.

C. All Claims Satisfy Guidelines for Computer Related Inventions

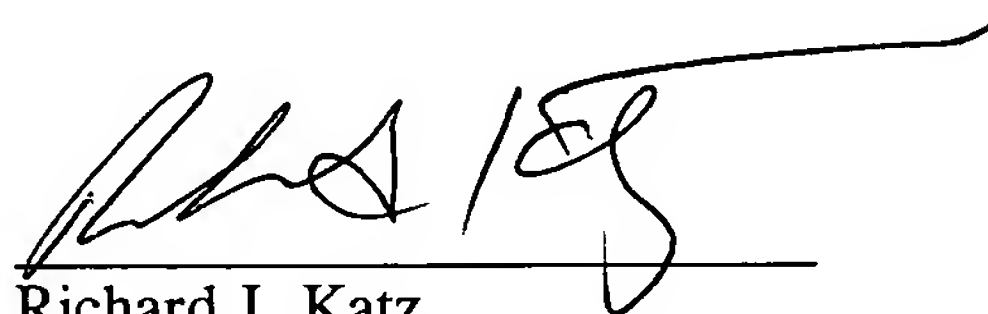
The specification and Remarks of record (*see* December 3, 2004 Response to Office Action, pages 20-26) establish numerous examples of statements of practical application. MPEP § 2106, Examination Guidelines for Computer Related Inventions (“Guidelines”), instruct that during examination the Examiner should point out statements made in the Specification that identify all practical applications for the invention, and that the Examiner should rely on such statements throughout the examination. MPEP page 2100-6. Further, the Guidelines instruct the Examiner that “only one [practical application] is necessary to satisfy the utility requirement.” The Examiner errs in failing to recognize that all of the pending claims, including the article claims 1-18 and 30-31, the article claims 32-49, 61-62 and 73-74, and the method claims 19-29, 50-60 and 63-72 satisfy the requirements of 35 U.S.C. § 101. Thus, claims 1-74 are statutory subject matter.

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Applicants believe that claims 1-74 are statutory subject matter and conform with the requirements of 35 U.S.C. § 101 et seq. Accordingly, Applicants request that the present rejection be withdrawn and the claims be passed to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard J. Katz', written over a horizontal line.

Richard J. Katz
Reg. No. 47,698
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Dated: August 11, 2005

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The sole question on appeal is whether the rejection of all claims as being directed to non-statutory subject matter under 35 U.S.C. § 101 is correct. *See* May 26, 2005 Office Action, page 2, item 5.

A. Method Claims Are Rejected In Error

The Examiner errs in rejecting these claims as being directed to a non-statutory subject matter. A process claim is statutory if it “produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful.” *See* MPEP, page 2100-18; *see also* December 3, 2004 Response to Office Action, page 19-21. Selected examples of the concrete, tangible and useful results that are recited in the pending method claims 19-29, 50-60 and 63-72 are “offering the unit for purchase and sale,” “offering the second unit for purchase and sale,” and “effecting the transfer of ownership of at least one of the equity and debt.” Accordingly, the method claims (claims 19-29, 50-60 and 63-72) are directed to statutory processes and the rejection of these claims should be withdrawn.

B. Article Claims Are Rejected In Error

Claims 1-18, 30-31, 32-49, 61-62 and 73-74 are within the Federal Circuit’s jurisprudence of what constitutes statutory subject matter. *See* December 3, 2004 Response to Office Action, page 21 (last paragraph) through page 26, for detailed arguments of Federal Circuit precedence and MPEP guidelines. These claims are directed to “an article suitable for trade.” The article recited in these claims is a new form of a capital structure for a company, representing equity and subordinated debt in a predetermined ratio as a tradeable unit. The structure of the claimed article suitable for trade is necessarily a transformation or reduction to a

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